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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/884,388 | 06/19/2001 | Xi Yuan Hua | J6662(C) | 3575 |
| 201 | 7590 | 04/21/2004 | EXAMINER | |
| UNILEVER PATENT DEPARTMENT 45 RIVER ROAD EDGEWATER, NJ 07020 | | | SHARAREH, SHAHNAM J | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1617 | |

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------|--------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/884,388 | HUA ET AL. | |
| | Examiner | Art Unit | |
| | Shahnam Sharareh | 1617 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Amendment filed on 2/17/04 has been entered. Claims 1-8 are pending. Any rejection that is not addressed in this Office Action is considered obviated in view of the Amendments.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-3, 6-8 stand rejected under 35 U.S.C. 102(b) as being anticipated by Foerster et al US Patent 5,980,874.

Applicant's arguments with respect to this rejection have been fully considered but are not found persuasive.

In response to applicant's argument that the instant claims are directed to "skin cleansing" microemulsions, Examiner states that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In the instant case the claims are directed to compositions comprising 5 different components. Foerster discloses all such components as recited in the previous Office Action. Forester discloses microemulsions comprising a fatty component such as octyl dodecanol in amounts of about 6.5% wt, a non-ionic surfactant in amounts of about 20%

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wt comprising alkyl glycoside with or without ethylene oxide products of fatty alcohols, co-emulsifier including linear or branched C8-C10 fatty alcohols, ethanol or isopropanol in amounts of about 2%, a thickening agent or perfume oil that meets the limitations of instant sensory agents, and a humectant such as propylene glycol (see abstract; col 3, lines 5-22 and 56-66; col 4, lines 24-67; col 5, lines 32-36; examples 1-5; and claims 1-2, 9-14). The amounts of co-surfactants used by Forester meet the limitations of the instantly claimed cosurfactant because Forester claims his ratio of nonionic emulsifier/coemulsifier as 2:1 to 15:1 (see claims 14). Since Forester claims up to 30% nonionic surfactant, the amounts of coemulsifier of Forester would fall within the instantly claimed ranges. The oils used by Forester are the same as those instantly claimed, because the instant specification at page 11 enumerates octyl dodecanol, coco caprylate/caprate and isopropyl myristate as such oils.

Thus, since Foerster's compositions comprise all elements of the instant claims, they inherently can perform any function as the instant compositions, because there is no structural difference between the claimed invention and the compositions taught by Foerster.

Claim Rejections - 35 USC § 103

Claims 1-8 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Forester et al US Patent 5,980,874.

Applicant's arguments with respect to this rejection have been fully considered but are not found persuasive.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Here, Foerster teaches all elements of the instant compositions for the reasons of record. Foerster merely fails to explicitly teach that instant specific concentrations of C2-C10 in his microemulsion. Nevertheless, the obviousness conclusion employed such knowledge that would have been available to one of ordinary skill in the art at the time of invention. Such use of knowledge is not improper hindsight, rather it is prima facie obviousness. Applicant has not provided any showing of unexpected results, thus, optimizing the amount of C2-C10 alcohols coemulsifiers to improve stability of the microemulsions of Foerster would have been achieved by routine experimentation.

Conclusion

No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahnam Sharareh whose telephone number is 571-272-0630. The examiner can normally be reached on 8:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, PhD can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SS


RUSSELL TRAVERS
PRIMARY EXAMINER